

REMARKS

The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. § 102(b) as being anticipated by Rognmo, U.S. Patent No. 4,157,068 (Rognmo). Claim 3 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Rognmo in view of Jacobson et al., U.S. Patent No. 4,127,243 (Jacobson). Claim 4 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Rognmo in view of Saxe et al., U.S. Patent No. 4,072,107 (Saxe). It is respectfully submitted that claims 1-5 are patentable over the cited references.

Specifically, the present invention relates to internal combustion-operated setting tool and, in particular, to propellant container for such tools. Rognmo relates to a missile for discharge towards a target. It is respectfully submitted that the preamble of claim 1 alone distinguishes the present invention over Rognmo.

The case law holds that “In general, a preamble limits the [claimed] invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim (emphasis added).” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 62 U.S.P Q. 2d 1781, 1784 (Fed. Cir. 2002) quoting

Pitney Bowes, Inc. v. Hewlett Packard Co., 51 U.S.P Q 2D 1161, 1165 (Fed. Cir. 1999).

In the present case, the preamble clearly gives vitality to claim 1 which recites in the preamble “a propellant container for internal combustion operated setting tools. . .”.

Catalina Mftg. Int’l, Inc. v. Coolsavings.com, Inc. only confirms a long held view that the preamble is given the effect of a limitation, is deemed essential to point out the invention defined by a claim, and is “considered necessary to give life, meaning and vitality to the claims” when “there inhered in the article specified in the preamble a problem, when transcended that before prior artisan. . .” *Kropa v. Robie and Maheman*, 88 U.S.P Q. 478, 481 (CCPA 1951). The same court further stated “The nature of the problem characterized the elements comprising the article, and recited in the body of the claim... So as to distinguish the claim over the prior art.”

The problem the present invention, as defined by claim 1, solves is a provision a propellant container that permits the tool operator to easily handle both the setting tool and the propellant container. It is unclear how Rognmo, the main objects of which are a missile which can be stored for longer periods

of time without the electrical or electronic components being damaged, and a missile which during and after the launching has an extra safety against unintentional detonation of the explosive charges caused by the influence of undesired jamming signals, contribute to the solution of the problem the present invention.

It is respectfully submitted that neither Rognmo nor Jacobson which relates to a device for a missile, or Saxe which relates to missile control means are pertinent to the present invention.

The case law holds that in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

In the present case, Rognmo, as discussed above, is neither in the field of applicant's endeavor nor is reasonably pertinent to the particular problem the applicant was concerned with. The same applies to Jacobson and Saxe.

Even assuming, *arguendo*, that Rognmo is a pertinent reference, it still would not anticipate the present invention, as defined by claim 1. Specifically, Rognmo does not disclose a housing in the inner space of which propellant is received.

In Rognmo, the intermediate part (3, 7a-7i) forms the propellant (column 3, lines 27-30). If one consider the missile (1) a housing, than the propellant would be part of the housing. Moreover, in their case, the power means (5) would be arranged in the container and no “on the propellant container,” as recited in claim 1.

Clearly, in Rognmo, the components of the structure are arranged differently than according to the present invention.

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. *Electro Medical Systems S.A. v. Cooper Life Sciences*, 32 U.S.P Q. 2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. V. Barient Inc.*, 3 U.S.P Q. 2d 1766, 1767-68 (Fed. Cir. 1987); *Verdegaal Bros., Inc. v. Union Oil Co.*, 2 U.S.P Q. 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the

presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 200 U.S.P Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P Q. 2d at 1019; Verdegaal Bros, 2 U.S.P Q. 2d at 1053.

Since Rognmo fails to disclose each and every feature of independent Claim 1, Rognmo, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

In view of the above, it is respectfully submitted that Rognmo does not anticipate or make obvious the present invention as defined in Claim 1, and the present invention is patentable over Rognmo taken alone, or in combination with Jacobson or Saxe.

Claims 2-5 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1 are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by an Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

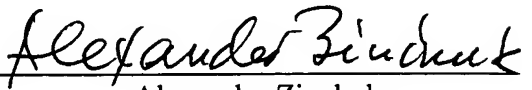


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